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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,403	01/28/2004	Thomas Foxen	005127.00276	2857
22909	7590	03/22/2006	EXAMINER	
BANNER & WITCOFF, LTD. 1001 G STREET, N.W. WASHINGTON, DC 20001-4597			MUSSER, BARBARA J	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CM

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/767,403		FOXEN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Barbara J. Musser		1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.  
     4a) Of the above claim(s) 45-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 and 49-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                                        |                                                                                         |
|--------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/13/04, 4/29/05</u> . | 6) <input type="checkbox"/> Other: ____.                                                |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-44 and 49-58, drawn to a method of making a sole, classified in class 156, subclass 285.
  - II. Claims 45-48, drawn to a method of making a shoe, classified in class 156, subclass 60.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require the reinforcing member. The subcombination has separate utility such as a method of making a cushion.

3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Byron Kuzara on 3/15/06 a provisional election was made without traverse to prosecute the invention of group I, claims 1-44 and 49-58. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 45-48 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Objections***

6. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 33-59 have been renumbered 32-58. Please use the renumbered claim numbers in further amendments.

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 10, 11, and 20-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "the second surface" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the first surface" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 20, it is unclear how the first side of the reinforcing element can be facing the mold cavity and therefore facing the bladder and yet the second side of the reinforcing element is the side bonded to the bladder. For the purposes of examination, it is assumed that the side of the reinforcing element facing the mold cavity is the side that contacts the bladder.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-6, 8, 9, 12, 14-17, 19-25, 27, 30-32, 34, 35, 37-43, and 49-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Shorten et al.(U.S. Patent 6,029,962).

Shorten et al. discloses a method of bonding a reinforcement to a bladder for use in a shoe wherein the reinforcement(110,116) is placed in a mold, two sheets of thermoplastic are placed in the mold, and the sheets of thermoplastic are urged against the mold walls and against the reinforcement.(Col. 13, ll. 23-28, 35-67) This forms a

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bladder filled with air, a fluid. The reinforcements are coated with adhesive, and therefore are bonded to the bladder.(Col. 14, ll. 6-8) Since the reinforcements are in indentations in the bladder, they are recessed into the bladder.(Figure 8)

Regarding claims 2 and 22, Shorten et al. discloses the two sheets are thermoplastic.(Col. 3, ll. 8-9)

Regarding claims 3, 23, 38, and 50, Shorten et al. discloses the two sheets which form the bladder can have different thicknesses.(Col. 3, ll. 13-16)

Regarding claim 4, Shorten et al. discloses the sheets can be stretched during molding.(Col. 10, ll. 33-35)

Regarding claims 5, 6, 24, 25, 39, and 40, Shorten et al. discloses that one of the sheets forms a first surface and part of a sidewall while a second sheet forms a second surface and part of a sidewall.(Figures 8 and 9)

Regarding claims 8 and 27, Shorten et al. discloses the bladder can be formed from a parison.(Col. 12, ll. 9-12)

Regarding claim 9, Shorten et al. discloses multiple interior bonds between parts of the bladder.(Figure 3)

Regarding claims 12 and 32, the bladder has depressions in it.(Figure 8)

Regarding claim 14, Shorten et al. discloses stretching the sheets during molding so that the mold around the inserts.(Col. 10, ll. 32-35; Figure 8)

Regarding claims 15 and 34, Shorten et al. discloses forcing the sheets against the inserts, effectively compressing them.(Col. 10, ll. 64-68)

Regarding claims 17, 30, 41, and 52, Shorten et al. discloses applying pressure between the two sheets.(Col. 11, ll. 31-35)

Regarding claims 17, 31, 42 and 53, Shorten et al. discloses pulling a vacuum to pull the sheets against the mold sides.(Col. 10, ll. 35-39)

Regarding claims 19, 36, and 43, Shorten et al. discloses the inserts can have holes, effectively forming vents which prevent air from being trapped therebetween.(Figures 11 and 16)

Regarding claim 20, since the polymer surrounds part of the reinforcement, it is extended around it.(Figure 8)

Regarding claim 38, the bladder is formed by drawing a first sheet against a first mold and a second sheet against a second mold.(Col. 10, ll. 53-57; Figure 8)

Regarding claim 49, the thermoforming bends the first sheet to form the sidewall. Shorten et al. discloses the two sheets, after being shaped to the shape of the molds, form a peripheral bond by compression of the sheets between the mold portions.(Col. 10, ll. 57-62)

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 7, 18, 26, 36, 44, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shorten et al. in view of Goodwin et al.(U.S. Patent 6,119,371).

Shorten et al. discloses as taught about, but does not disclose a first sheet of the bladder by making a first side and the sidewall while a second sheet makes up a second side, and bonding them together at the intersection of the second side and the sidewall. Goodwin et al. discloses forming a bladder by making a first side and the sidewall while a second sheet makes up a second side, and bonding them together at the intersection of the second side and the sidewall so that the seam is located away from the area of maximum flexing of the sidewall of the bladder.(Figure 8A; Col. 4, ll. 65-67) It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the bladder of Shorten et al. so that the bladder has an intersection of the two sheets between the sidewall and one of the sheets rather than at the midpoint of the sidewall since this would locate the seam away from the area of maximum flexing of the sidewall.(Col. 4, ll. 65-67)

Regarding claims 18, 36, and 44, while Goodwin et al. does not disclose beveling the edge of the bladder, it is cut.(Figure 9C) This is considered to be beveled.

Regarding claim 51, one in the art would appreciate that the sheet would have a uniform thickness prior to placement in the mold.

13. Claims 1, 13, 20, 28, 29, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyden et al.(U.S. Patent 5,595,004) in view of Shorten et al.

Lyden et al. discloses a bladder for a shoe which can be made in a variety of ways.(Abstract; Col. 4, ll. 55) The shoe also has a reinforcement(9) which is not



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bonded to the bladder. The reference does not disclose applying a reinforcement to a mold, forming a bladder by drawing a polymer against the mold and reinforcement, and bonding them together. Shorten et al. discloses a method of bonding a reinforcement to a bladder for use in a shoe wherein the reinforcement(110,116) is placed in a mold, two sheets of thermoplastic are placed in the mold, and the sheets of thermoplastic are urged against the mold walls and against the reinforcement.(Col. 13, ll. 23-28, 35-67) This forms a bladder filled with air, a fluid. The reinforcements are coated with adhesive, and therefore are bonded to the bladder.(Col. 14, ll. 6-8) Since the reinforcements are in indentations in the bladder, they are recessed into the bladder.(Figure 8) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of Shorten et al. to form the bladder and to bond the reinforcement(9) to the bladder since this would form a strong bond between them.

Regarding claims 11 and 29, Lyden et al. discloses a flexion(171, 172) in the bladder but does not disclose bonding one side of the flexion to the second side of the bladder. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the flexion so that it contacts the second side of the bladder so that the flexion has enough depth to flex as is desired.

Regarding claim 28, Lyden et al. discloses a flexion(171, 172) in the bladder.

Regarding claims 13 and 33, the reinforcement(9) is flush with the outside of the bladder.(Figure 2e)

14. Claims 49 and 54-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodwin et al. in view of Shorten et al.

Goodwin et al. discloses forming a bladder having a plurality of connecting portions between a first and second side.(Figure 9C) The reference does not disclose applying a reinforcement to a mold, forming a bladder by drawing a polymer against the mold and reinforcement, and bonding them together. Shorten et al. discloses a method of bonding a reinforcement to a bladder for use in a shoe wherein the reinforcement(110,116) is placed in a mold, two sheets of thermoplastic are placed in the mold, and the sheets of thermoplastic are urged against the mold walls and against the reinforcement.(Col. 13, ll. 23-28, 35-67) This forms a bladder filled with air, a fluid. The reinforcements are coated with adhesive, and therefore are bonded to the bladder.(Col. 14, ll. 6-8) Since the reinforcements are in indentations in the bladder, they are recessed into the bladder.(Figure 8) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of Shorten et al. to form the bladder and to bond the reinforcement(9) to the bladder since this would form a strong bond between them.

Regarding claim 57, Shorten et al. discloses applying pressure between the two sheets.(Col. 11, ll. 31-35)

Regarding claim 58, Shorten et al. discloses pulling a vacuum to pull the sheets against the mold sides.(Col. 10, ll. 35-39)

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara J. Musser whose telephone number is (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
BJM

  
SAM CHUAN YAO  
PRIMARY EXAMINER